



1655

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Attorney Docket No. 98,429)

In the Application of:

Hasel, et al.

Serial No.: 09/186,869

Filed: November 4, 1998

For: METHOD FOR INDEXING AND  
DETERMINING THE RELATIVE  
CONCENTRATION OF EXPRESSED  
MESSENGER RNA'S

Examiner: J. Fredman

Group Art Unit: 1655

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

**TRANSMITTAL LETTER**

In regard to the above identified application:

1. We are transmitting herewith the attached:
  - A. Response to Restriction Requirement;
  - B. Return Receipt Postcard.
2. With respect to additional fees, no additional fee is required.
3. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2490. A duplicate copy of this sheet is enclosed.
4. CERTIFICATE OF MAILING UNDER 37 CFR § 1.8: The undersigned also hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231 on this 18<sup>th</sup> day of August, 2000.

By: 

Roger P. Zimmerman  
Reg. No. 38,670

RECEIVED  
AUG 28 2000  
TECH CENTER 1600/2900

RECEIVED  
AUG 28 2000  
TECH CENTER 1600/2900



#18  
B. Webb  
PATENT 9/27/00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

(Case No. 98,429)

In re Application of:

Hasel & Hilbush

Serial No.: 09/186,869

Filed: November 4, 1998

Examiner: J. Fredman

Group Art Unit: 1655

For: **METHOD FOR INDEXING AND DETERMINING THE RELATIVE CONCENTRATION OF EXPRESSED MESSENGER RNAS**

RECEIVED  
AUG 28 2000  
TECH CENTER 1500 2200

**RESPONSE TO RESTRICTION REQUIREMENT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants submit this response in reply to the restriction requirement mailed on July 21, 2000. Applicants select Group I with traverse. Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

The restriction requirement listed three groups of inventions:

Group I (Claims 1-36 and 42-72) stated to refer to methods of nucleic acid indexing;

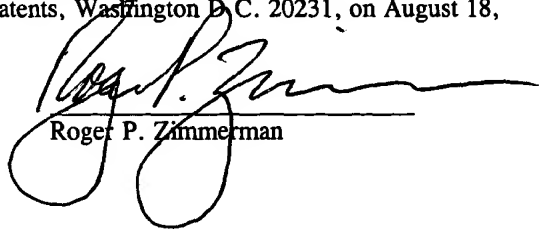
Group II (Claims 37-41) stated to refer to vectors; and

Group III (Claims 73 and 74) stated to refer to databases.

**CERTIFICATE OF MAILING (37 C.F.R. 1.8a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner of Patents, Washington D.C. 20231, on August 18, 2000.

Date: August 18, 2000

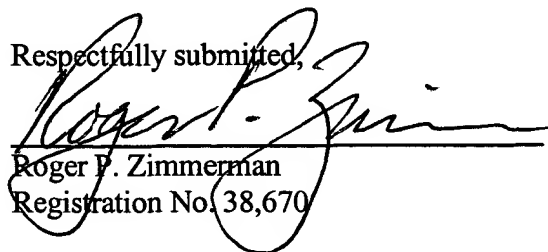
  
Roger P. Zimmerman

Applicants respectfully submits that all groups are unified by the underlying technical feature of identifying a polynucleotide fragment of determinable length that is bounded at its 3' end by a poly(A) "tail" and bounded on its 5' end by at least a portion of a recognition site of a restriction endonuclease and an adjacent known sequence of 2-6 nucleotides that is produced by the method of Group I. The vectors of Group II comprise specifically engineered sequences that provide recognition sites for restriction endonucleases upstream of the bacteriophage-specific promoter site required for the practice of the method of Group I, as recited, e.g., in step (e) of claim 1. One of skill in the art would not choose such vectors for simple expression given the numerous vectors already conveniently available for that purpose. Similarly the databases of Group III are inherently linked to Group I, since they are limited to containing the data produced by claim 1, and therefore possess the above underlying technical feature.

For the reasons discussed above, Applicants respectfully requests reconsideration of the restriction requirement based on the unity of invention provided by the stated technical feature.

It is believed that no fee is due in relation to this filing; however, if a fee is due, please charge our Deposit Account No. 13-2490.

Dated: August 18, 2000

Respectfully submitted,  
  
Roger P. Zimmerman  
Registration No. 38,670

McDonnell Boehnen Hulbert & Berghoff  
300 South Wacker Drive, Suite 3200  
Chicago, Illinois 60606  
Telephone No. 312-913-0001  
Facsimile No. 312-913-0002